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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,690	10/20/2000	Kia Silverbrook	NPA064US	8647
24011 7590 04/09/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER PORTER, RACHEL L				
ART UNIT		PAPER NUMBER		
3626				
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04/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/693,690

Applicant(s)

SILVERBROOK ET AL.

Examiner

RACHEL L. PORTER

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-31 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-31 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the amendment filed 1/3/08. Claims 1-6, 8-31, and 34-44 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-31, and 34-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al (USPN 6,076,734) in view of Henderson et al (USPN 5,737,740) and in further view of Luchs (USPN 4,831,526).

As per claims 1-6, 8-26, Dougherty teaches a method for using a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on an encoded physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46). Furthermore, the sensing device in the Dougherty reference measures information within a desired region of interest on a physical surface. (col. 7, lines 21-32)

However, Dougherty does not expressly disclose that computer system receives indicating data from the sensing device regarding its position relative to the form or physical medium. Henderson discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and stored within the computer system (Figure 1, col. 14, lines 35-55; col.15, lines 10-29) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dougherty with the teaching of Henderson to record information on movement/location of the sensing device relative to the document/physical medium. As suggested by Henderson, one would have been motivated to include this feature to facilitate future access to electronic documents for archival or editing purposes. (col. 3, lines 20-37)

Dougherty and Henderson do also not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Dougherty and Henderson with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services.

One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

As per claims 27-31, 33-44, Dougherty teaches a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on a physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46).

However, Dougherty does not expressly disclose that computer system receives indicating data from the sensing device regarding its position relative to the form or physical medium. Henderson discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and stored within the computer system (Figure 1, col. 14, lines 35-55; col.15, lines 10-29) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dougherty with the teaching of Henderson to record information on movement/location of the sensing device relative to the

document/physical medium. As suggested by Henderson, one would have been motivated to include this feature to facilitate future access to electronic documents for archival or editing purposes. (col. 3, lines 20-37)

Dougherty and Henderson do also not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a system further comprising a printer and forms, wherein the forms relate to insurance services. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses that customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system Dougherty and Henderson with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

Response to Arguments

4. Applicant's arguments with respect to claims 1-6, 8-31, and 34-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/Robert Morgan/
Primary Examiner, Art Unit 3626